

Appl. No. 10/730,522  
Reply to Office Action of July 20, 2004

Remarks

Introduction

Claims 1-35 were pending, and claims 1-29 are under examination. By way of this response, claims 1, 5, 7, 8, 14, 17, 22 have been amended; claims 3, 4, 6, 9, 21, and 30-35 have been cancelled without prejudice; and claims 36-42 have been added. Support for the amendments to the claims and the new claims can be found in the application as originally filed, and care has been taken to avoid adding new matter. Accordingly, claims 1, 2, 5, 7, 8, 10-20, 22-29, and 36-42 are currently pending.

Rejection under 35 U.S.C. § 112, second paragraph

Claim 6 has been rejected under 35 U.S.C. § 112, second paragraph as being indefinite.

Claim 6 has been cancelled, as set forth above, and therefore, the rejection is moot.

Rejections under 35 U.S.C. § 102

Claims 1-7, 9-10, 12-15, 17-27, and 29 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Cohen (U.S. Pat. No. 4,889,421). Claims 1-2, 12, 14, 16-18, 20, 23, 25-27, and 29 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Quinn et al. (U.S. Pub. No. 2003/0054109). Claims 1-13, 15, 17-23, and 29 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Li et al. (U.S. Pat. No. 6,164,777).

Appl. No. 10/730,522  
Reply to Office Action of July 20, 2004

As a preliminary matter, and for the record, applicant notes that Quinn et al. was published on March 20, 2003. The above-identified application was filed on December 8, 2003 and has an effective filing date of December 13, 2002. Applicant submits that Quinn et al. is not a proper reference under 35 U.S.C. § 102(b) since Quinn et al. was not published more than 1 year prior to the effective filing date of the above-identified application. Applicant will assume the Examiner meant to apply Quinn et al. as a § 102(e) reference.

The claims have been amended as set forth above. Applicant traverses the rejections as they relate to the present claims.

Regarding the rejection of the claims over Quinn et al., applicant has amended independent claim 1 and claim 17 to include the subject matter of original claim 3, which was not indicated as being anticipated by Quinn et al. Therefore, applicant submits that the rejection of the present claims over Quinn et al. has been overcome.

Regarding the rejection of the claims over Cohen, applicant submits that Cohen discloses a contact lens having a pattern formed by using a colored liquid (e.g., col 12, line 19, col 12, lines 28-50). Thus, the image component of the contact lens disclosed by Cohen necessarily includes an intrinsic color. Applicant submits that a substantial portion of the image component of the contact lens of Cohen is colored, and more specifically, is not a film that is substantially absent of any intrinsic color.

Appl. No. 10/730,522  
Reply to Office Action of July 20, 2004

Applicant submits that Cohen does not disclose, teach, or suggest the present invention. For example, Cohen does not disclose, teach, or even suggest a contact lens comprising an image component comprising particles of a multilayered interference film that is substantially absent of any intrinsic color, let alone, such a contact lens comprising an image component initially provided to the lens body or a precursor thereof in a liquid binder material comprising such particles, as recited in claim 1 and claim 17.

In addition, applicant submits that Cohen does not disclose an image component which comprises a plurality of particles of an interference film. Instead, the image component of the contact lens of Cohen, is formed using a colored liquid which comprises a colorant. The only disclosure by Cohen of colorants are dyes used in tinting contact lenses, and pigmentary materials used to color contact lenses (col 12, lines 36-40). As discussed in the specification of the above-identified application, applicant submits that the interference film recited in the present claims is different and distinct from the colorant disclosed by Cohen. For example, the interference film recited in the present claims is substantially absent of any intrinsic color. Conventional dyes and pigmentary materials disclosed by Cohen are colored, or are not substantially absent of intrinsic color.

Regarding the rejection of the claims over Li et al., applicant submits that Li et al. discloses a contact lens which has an interference coating that does not include particles of an interference film in a liquid binder material. The coating disclosed by Li et al. is provided to a lens as a gas or vapor,

Appl. No. 10/730,522  
Reply to Office Action of July 20, 2004

not as a liquid, let alone a liquid binder material. In particular, Li et al. uses plasma enhanced chemical vapor deposition (PECVD) to apply the interference coating onto the contact lens. Ion-assisted evaporation is used to solidify the vapor of the interference coating. Thus, applicant submits that Li et al. does not disclose, teach, or even suggest all of the limitations recited in the present claims.

Applicant submits that Li et al. does not disclose, teach, or suggest the present invention. For example, Li et al. does not disclose, teach, or even suggest a contact lens comprising an image component initially provided to a lens body, or a precursor thereof, in a liquid binder material which comprises particles of a multilayered interference film that is substantially absent of any intrinsic color, as recited in the present claims. The liquid binder material is applied to the lens using techniques other than chemical vapor deposition, as disclosed by Li et al. For example, the liquid can be applied by pad printing techniques or using ink jet printer techniques.

In view of the above, applicant submits that the present claims, and claims 1-27 and 29 in particular, are not anticipated by Cohen, Quinn et al., or Li et al. under 35 U.S.C. § 102.

Applicant also submits that the present claims are unobvious from and patentable over Cohen, Quinn et al., or Li et al., taken alone, or in any combination under 35 U.S.C. § 103.

In addition, applicant submits that each of the present dependent claims is separately patentable over the prior art.

Appl. No. 10/730,522  
Reply to Office Action of July 20, 2004

For example, none of the prior art disclose, teach, or even suggest the present contact lenses including the additional feature or features recited in any of the present dependent claims. Therefore, applicant submits that each of the present claims is separately patentable over the prior art. For example, applicant submits that the prior art does not disclose, teach, or even suggest contact lenses that have particles of an interference film that were combined with a passivator before being provided on the lens body, as recited in claims 37 and 39, or which include particles of the sizes recited in claims 38 and 40.

#### Allowable Subject Matter

Claim 28 has been objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form.

Claim 28 has been rewritten as independent claim 36 and includes the subject matter of the base claim and any intervening claim. Therefore, applicant submits that claim 36 is in condition for allowance.

#### Conclusion

In conclusion, applicant has shown that the present claims satisfy the requirements of 35 U.S.C. § 112, and are not anticipated by and are unobvious from and patentable over the prior art under 35 U.S.C. §§ 102 and 103. Therefore, applicant submits that the present claims, that is claims 1, 2, 5, 7, 8, 10-20, 22-29, and 36-42, are allowable. Therefore, applicant

Appl. No. 10/730,522  
Reply to Office Action of July 20, 2004

respectfully requests the Examiner to pass the above-identified application to issuance at an early date. Should any matters remain unresolved, the Examiner is requested to call (collect) applicant's attorney at the telephone number given below.

Date: 10/18/04

Respectfully submitted,



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